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SEED INTELLECTUAL PROPERTY LAW GROUP PLLC			DEXTER, CLARK F	
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Please find below and/or attached an Office communication concerning this application or proceeding.

SP

Office Action Summary	Application No. 09/680,697	Applicant(s) COLLINS, WALTER W.	
	Examiner Clark F. Dexter	Art Unit 3724	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 17 May 2005.
 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-31,33,34,36,37,45 and 47-64 is/are pending in the application.
 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
 5) ☐ Claim(s) _____ is/are allowed.
 6) ☒ Claim(s) _____ is/are rejected.
 7) ☐ Claim(s) _____ is/are objected to.
 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 a) ☐ All b) ☐ Some * c) ☐ None of:
 1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>10/25/05</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. The amendment filed on May 17, 2005 has been entered.

Information Disclosure Statement

2. The information disclosure statement filed on October 25, 2005 has been received and the references listed thereon have been considered.

Claim Objections

3. Claims 58-62 are objected to because of the following informalities:

In claim 58, line 7, it seems that a word such as --an-- is missing before "opening".

In claim 62, line 7, it seems that a word such as --an-- is missing before "opening".

Appropriate correction is required.

Claim Rejections - 35 USC § 112, 1st paragraph

4. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

5. Claims 55-64 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter

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which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

The original disclosure does not appear to provide support for a (single) biasing element that is operatively coupled at a first end thereof to the handle by a first coupling element, and is operatively coupled at a second end thereof to the blade by a second coupling element as set forth in claims 55, 58 and 62-64. Rather, support is provided for a biasing element 90 that is part of a plunger assembly E, wherein a first end of the plunger assembly is operatively coupled to the handle by a first coupling element 92 and wherein a second end of the plunger assembly is operatively coupled to the blade by a second coupling element 86.

Claim Rejections - 35 USC § 112, 2nd paragraph

6. Claims 45, 54, 57, 60 and 61 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In claim 45, lines 5-6, the recitation "coupled between the handle and the blade" is vague and indefinite as to what it refers (e.g., the handle or the spring).

In claim 54, line 2, "the tang" lacks positive antecedent basis.

In claim 57, line 3, "id" renders the claim vague and indefinite as to what is being set forth.

In claim 60, line 3, "the tang" lacks positive antecedent basis.

In claim 61, line 2, "the tang" lacks positive antecedent basis.

Claim Rejections - 35 USC § 102

7. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

8. Claims 12 and 19-21 are rejected under 35 U.S.C. 102(b) as being anticipated by French publication 1.069.862 (hereafter FP '862).

FP '862 discloses a folding knife with every structural limitation of the claimed invention including a handle (e.g., 1, 2) defining a blade cavity; a blade (e.g., 5) having a blade pivot (e.g., 7) connected to the first end of the handle; a plunger assembly (e.g., 14, 15), wherein the first end of the plunger assembly is slidably and pivotably connected to the handle (e.g., it is slidable between components 1 and 3, and pivotable as shown in Figures 3-4), and the second end (e.g., 14) of the plunger assembly is pivotally connected to the first end of the blade.

Further, the plunger assembly is "configured to maintain the blade in the extended position while the blade is in the extended position and to retain the blade in the retracted position while the blade is in the retracted position." For example, the plunger assembly (e.g., 14, 15) of FP '862 causes an amount of interference and/or friction in moving the blade from the extended (i.e., open) position and from the retracted (i.e., closed) position, and thus tends to assist in maintaining the blade in the

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extended position and assist in retaining the blade in the retracted position. It is noted that, while the amount of interference and/or friction may be minimal, there is nonetheless interference and/or friction. Further, the plunger assembly does not bias or otherwise tend to force the blade out of the extended or retracted positions. Thus, the plunger assembly can be broadly and fairly interpreted as being "configured to maintain the blade in the extended position while the blade is in the extended position and to retain the blade in the retracted position while the blade is in the retracted position."

9. Claims 23, 29, 45, 52, 55-59 and 62-64 are rejected under 35 U.S.C. 102(b) as being anticipated by Brown, pn 1,864,011.

Brown discloses a folding knife with every structural limitation of the claimed invention including a blade (e.g., 1), and a plunger (e.g., 3) including a spring (e.g., 8), the plunger pivotally connected to the blade (e.g., via 11), and the spring adapted to perform the recited function including causing the spring to assist opening of the blade when the blade is pivoted from the retracted position toward the extended position beyond the intermediate point.

Regarding claims 23 and 29, the plunger (e.g., 3) is pivotally connected to the blade (e.g., 1) by pins (e.g., the rightmost occurrence of 11, 13) and openings (e.g., the rightmost occurrence of 5, 14) at a first end (of the plunger), and is operably coupled to the handle by pins (e.g., the leftmost occurrence of 11, 12 through openings (e.g., the leftmost occurrence of 5, 6) at a second end (of the plunger).

Regarding claim 45, Brown meets the limitation "coupled between the handle and the blade such that a portion of the plunger remains a fixed distance from the blade

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pivot point.” For example, the leftmost portion of the plunger remains a fixed distance from the blade pivot point (e.g., the rightmost occurrence of 11).

Regarding claims 52 and 53, Brown discloses a handle (e.g., 9), a blade (e.g., 1), a biasing means (e.g., 8), moving means (e.g., the notch located on the blade between numerals 1 and 7, wherein the notch can clearly be accessed by a finger of a user’s hand and pushed toward an open/extended position while the user is holding the knife in the same hand), and a pivotal connector (e.g., 11 and/or 12).

Regarding claims 55-57, Brown discloses a handle (e.g., 9), a blade (e.g., 1), a single biasing element including a spring (e.g., 8), a first coupling element (e.g., the leftmost portion of element 3), a second coupling element (e.g., the rightmost portion of element 3), and an engagement element (e.g., the notch located on the blade between numerals 1 and 7).

Regarding claims 58 and 59, Brown discloses a handle (e.g., 9), a blade (e.g., 1), a contact element (e.g., the notch located on the blade between numerals 1 and 7), a biasing element including a spring (e.g., 8), a first coupling element (e.g., the leftmost portion of element 3), a second coupling element (e.g., the rightmost portion of element 3).

Regarding claims 62-64, Brown discloses a handle (e.g., 9), a blade (e.g., 1), a contact element (e.g., the notch located on the blade between numerals 1 and 7), a biasing element including a spring (e.g., 8), a first coupling element (e.g., the leftmost portion of element 3), a second coupling element (e.g., the rightmost portion of element 3).

Claim Rejections - 35 USC § 102/103

10. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

11. Claim 28 is rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Brown, pn 1,864,011 (Brown '011).

Brown '011 discloses a folding knife with every structural limitation of the claimed invention including a clevis as claimed including pin (e.g., 13).

In the alternative, if it is argued that Brown '011 lacks the first end of the plunger including a clevis having a pin pivotally connected to the first end of the blade, the Examiner takes Official notice that such rotatable connections are old and well known in the art and provide various known benefits including providing a sturdy, unbiased connection for relative rotation between two components. Therefore, it would have been obvious to one having ordinary skill in the art to provide a clevis on the second end of the plunger for the well known benefits including those described above.

Claim Rejections - 35 USC § 103

Obviousness Rejections Based on French Patent 1.069.862

12. Claim 13 is rejected under 35 U.S.C. 103(a) as being unpatentable over French Patent 1.069.862 (FP '862) in view of Thompson et al., pn 5,131,149 (Thompson '149).

FP '862 lacks the first end of the blade having an extension with a plurality of ridges thereon. Thompson '149 discloses a blade having such a plurality of ridges on a first end of the blade and teaches that it facilitates one-handed actuation of the blade. Therefore, it would have been obvious to one having ordinary skill in the art to provide an extension having a plurality of ridges on the blade of FP '862 for the benefits taught by Thompson '149 including that described above.

13. Claim 16 is rejected under 35 U.S.C. 103(a) as being unpatentable over French Patent 1.069.862 (FP '862) in view of Seber et al., pn 5,546,662.

FP '862 lacks a belt clip connected to the handle adjacent one of the sides of the handle. Seber discloses such a clip for attachment to a belt. Such an attachment provides various obvious and well known benefits including freeing the hands for use while still maintaining possession of the knife and while providing easy and quick access to the knife. Therefore, it would have been obvious to one having ordinary skill in the art to provide a belt clip on the knife of FP '862 for the obvious and well known benefits including those taught by Seber as described above.

14. Claim 17 is rejected under 35 U.S.C. 103(a) as being unpatentable over French Patent 1.069.862 (FP '862).

FP '862 lacks the second end of the plunger including a clevis having a pin pivotally connected to the first end of the blade. However, the Examiner takes Official notice that such rotatable connections are old and well known in the art and provide various known benefits including providing a sturdy, unbiased connection for relative rotation between two components. Therefore, it would have been obvious to one

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having ordinary skill in the art to provide a clevis on the second end of the plunger for the well known benefits including those described above.

15. Claim 18 is rejected under 35 U.S.C. 103(a) as being unpatentable over French Patent 1.069.862 (FP '862) in view of Brown, pn 1,701,027.

FP '862 lacks the first end of the blade having an arcuate slot, and the handle including a pin carried in the arcuate slot. However, the Examiner takes Official notice that such configurations are old and well known in the art as evidenced by Brown and provide various known benefits including providing stability to the knife, and particularly additional stability between the knife and the handle during opening and closing of the knife. Therefore, it would have been obvious to one having ordinary skill in the art to provide the first end of the blade having an arcuate slot, and the handle including a pin carried in the arcuate slot for the well known benefits including those described above.

Obviousness Rejections Based on Brown, pn 1,864,011

16. Claims 24, 54, 60 and 61 are rejected under 35 U.S.C. 103(a) as being unpatentable over Brown, pn 1,864,011 (Brown '011) in view of Thompson et al., pn 5,131,149 (Thompson '149).

Brown '011 lacks the first end of the blade having an extension with a plurality of ridges thereon or, for claims 54 and 60, a plurality of directional saw-like teeth, or a pin coupled to an upper portion of the blade. Thompson '149 discloses a blade having such a plurality of ridges on a first end of the blade and teaches that it facilitates one-handed actuation of the blade. Therefore, it would have been obvious to one having ordinary

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skill in the art to provide an extension having a plurality of ridges on the blade of Brown '011 for the benefits taught by Thompson '149 including that described above.

17. Claim 27 is rejected under 35 U.S.C. 103(a) as being unpatentable over Brown, pn 1,864,011 (Brown '011) in view of Seber et al., pn 5,546,662.

Brown '011 lacks a belt clip connected to the handle adjacent one of the sides of the handle. Seber discloses such a clip for attachment to a belt. Such an attachment provides various obvious and well known benefits including freeing the hands for use while still maintaining possession of the knife and while providing easy and quick access to the knife. Therefore, it would have been obvious to one having ordinary skill in the art to provide a belt clip on the knife of Brown '011 for the obvious and well known benefits including those taught by Seber as described above.

18. Claims 34, 36 and 51 are rejected under 35 U.S.C. 103(a) as being unpatentable over Brown, pn 1,864,011 (Brown '011).

Brown discloses a folding knife with almost every structural limitation of the claimed invention including a blade (e.g., 1), and an elongate, force-transmitting spring (e.g., 8) that performs the recited function(s), and a plunger (e.g., the portion to which the lead line for numeral 3 contacts). Further, the spring of Brown is operatively attached between the blade and the handle; for example, the spring (e.g., 8) is operatively attached to the handle via the leftmost portion corresponding to 3 and the associated pins (e.g., 11, 12) and openings (e.g., 5, 6), and the spring is also operatively connected to the blade via the rightmost portion corresponding to 3 and the associated pins (e.g., 11, 13) and openings (e.g., 5, 14).

Brown lacks the spring operating in the claimed direction; that is, a spring that exhibits the decrease in effective length as the blade is moved from one of the stowed and deployed conditions toward an intermediate point, and an increase in effective length as the blade is moved from the intermediate point toward the other conditions. However, it is old and well known in the art that springs operating in tension are equivalent to springs operating in compression, particularly since such springs are well known equivalents. Therefore, it would have been obvious to one having ordinary skill in the art to simply change the type of the spring that operates in tension to a spring that operates in compression.

Issues Relating to Reissue Application

19. Claims 23-64 are rejected under 35 U.S.C. 251 as being an improper recapture of broadened claimed subject matter surrendered in the application for the patent upon which the present reissue is based. See *Pannu v. Storz Instruments Inc.*, 258 F.3d 1366, 59 USPQ2d 1597 (Fed. Cir. 2001); *Hester Industries, Inc. v. Stein, Inc.*, 142 F.3d 1472, 46 USPQ2d 1641 (Fed. Cir. 1998); *In re Clement*, 131 F.3d 1464, 45 USPQ2d 1161 (Fed. Cir. 1997); *Ball Corp. v. United States*, 729 F.2d 1429, 1436, 221 USPQ 289, 295 (Fed. Cir. 1984). A broadening aspect is present in the reissue which was not present in the application for patent. The record of the application for the patent shows that the broadening aspect (in the reissue) relates to claim subject matter that applicant previously surrendered during the prosecution of the application. Accordingly, the narrow scope of the claims in the patent was not an error within the meaning of 35

U.S.C. 251, and the broader scope of claim subject matter surrendered in the application for the patent cannot be recaptured by the filing of the present reissue application.

Each of reissue claims 23, 30, 33, 34, 45, 47, 47, 52, 55, 58 and 62-64 (i.e., claims added in the reissue application) is an independent claim that fails the Third Step of the test set forth by the Court of Appeals for the Federal Circuit (see MPEP 1412.02). Specifically, at least one of the limitations added during the prosecution of the patent to distinguish over the prior art (that is, at least one of the surrender-generating limitations) was:

“the first end of the plunger being slidably carried by said pivotal connector as said blade moves between said retracted and extended positions.”

While reissue claim 12 is broader than patent claim 1 in the area of surrender, it does not entirely omit the limitation but rather sets forth that the first end of the plunger *assembly* is slidably and pivotally connected to the *handle*, rather than being slidably connected to a pivotal connector that is connected the handle. Thus, claim 12 merely recites a broader form of the key limitation added/argued during original prosecution to overcome an art rejection. It is noted that reissue claim 12 is considered narrower than patent claim 1 in other respects; specifically, the subject matter in the third paragraph of the claim which recites that the plunger assembly is configured to maintain the blade in the extended position ... , and to retain the blade in the retracted position

However, none of reissue claims 23, 30, 33, 34, 45, 47, 47, 52, 55, 58 and 62-64 include a recitation relating to the surrender-generating limitation recited above. Thus,

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these claims impermissibly recapture what was previously surrendered, and are barred under 35 U.S.C. 251.

Allowable Subject Matter

20. Claims 14, 15 and 22 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Response to Arguments

21. Applicant's arguments filed May 17, 2005 have been fully considered but they are not persuasive.

Regarding applicant's arguments on pages 14-15 of the response regarding the prior art rejection to claim 12, the Examiner respectfully submits that the prior art meets the functional recitations in the manner further described in the prior art rejection above.

Regarding applicant's arguments on pages 14-15 of the response regarding the prior art rejection to claim 23, it is respectfully submitted that the Examiner's position is not that there is an influence by the plunger on the blade, or vice versa. Rather, the Examiner's position is that Brown discloses a plunger that is pivotally connected to the blade as required by claim 23.

Regarding applicant's arguments on pages 15-16 of the response regarding the prior art rejection to claim 45, the Examiner respectfully submits that the prior art meets the claimed limitations in the manner further described in the prior art rejection above.

Regarding applicant's arguments on pages 16-17 of the response regarding the prior art rejection to claim 13 and 24, the Examiner respectfully disagrees with applicant's analysis regarding the combination of the applied prior art. It is respectfully submitted that the test for obviousness is not whether the features of a secondary reference may be bodily incorporated into the structure of the primary reference; nor is it that the claimed invention must be expressly suggested in any one or all of the references. Rather, the test is what the combined teachings of the references would have suggested to those of ordinary skill in the art.

Regarding applicant's arguments on pages 17-18 of the response regarding the prior art rejection to claims 34 and 36, the Examiner respectfully submits that the prior art meets the claimed limitations in the manner further described in the prior art rejection above.

Regarding applicant's arguments on pages 18-22 of the response regarding the recapture rejection, the Examiner respectfully submits that the claims impermissibly recapture what was previously surrendered in the manner further described in the recapture rejection above. Further, regarding the interview summary from the personal interview on October 16, 1997 (paper no. 9), the following was recorded:

"Mr. Epting proposed changes to claim 1 which included some of the subject matter of allowable claim 6. The proposed language would include a limitation describing the plunger as being slidably carried by the pivotal connector. Mr. Dexter stated that such an amendment appeared to distinguish the present invention over the French Patent '740."

Thus, it can be seen that the limitation added to patent claim 1 from patent claim 6 is directed to the structure providing a slidable relationship between the plunger and the pivotal connector. While patent claim 6 recites the specific structure to provide the slidable relationship, for example:

“the first end of the plunger moves substantially rectilinearly in said passage as said blade is moved between said retracted and extended positions,”

claim 1 was not amended to include the specific structure, but rather was amended to broadly recite the slidable relationship provided thereby:

“the first end of the plunger being slidably carried by said pivotal connector as said blade moves between said retracted and extended positions.”

Thus, it is respectfully submitted that the above limitation was added to distinguish over the prior art of record and thus must be considered to be a surrender-generating limitation that must be present in some form in any claims added by reissue.

Claim Rejections - Defective Oath/Declaration

22. It is noted that a new declaration has not been submitted. However, as requested by applicant, the requirement to submit a proper declaration corresponding to the claims of record has been held in abeyance until further notice.

Conclusion

23. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

24. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Clark F. Dexter whose telephone number is (571)272-4505. The examiner can normally be reached on Mondays, Tuesdays, Thursdays and Fridays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Allan N. Shoap can be reached on (571)272-4514. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Clark F. Dexter
Primary Examiner
Art Unit 3724

cfd
January 11, 2006